

**Remarks**

Initially, Applicants note that the claims are amended in response to the Office's objection relating to the recitation of "B71," which should be "B7-1." Applicants amended the claims to correct this clerical error and respectfully submit the objection is obviated by the amendment.

Applicants note that the sole remaining rejection is of claims 1, 3-6, 10, and 13, under 35 U.S.C. § 102(b) over Srinivasan et al. (*in* Peptides for the New Millennium, pp. 689-690, 1999). Applicants also note that the Office has made a requirement for information, under 37 C.F.R. § 1.105, relating to Srinivasan et al.

Requirement for Information Under 37 C.F.R. § 1.105

Initially, with regard to the requirement for information, Applicants submit herewith an executed Affidavit from inventor Pravin Kaumaya, which provides the information required by the Office. Applicants respectfully submit that the requirement for information is satisfied by this submission.

Rejection Under 35 U.S.C. § 102(b)

Turning to the substance of the rejection, Applicants respectfully submit that the rejected claims are not anticipated.

Applicants maintain that the cited publication does not constitute an anticipating disclosure under 35 U.S.C. § 102(b). To anticipate an invention under Section 102(b), a prior art reference must teach how to practice the allegedly anticipated invention. As the Federal Circuit said in *In re Donohue*, 766 F.2d 531, 226 U.S.P.Q. 619 (Fed. Cir. 1985):

It is well settled that prior art under 35 U.S.C. §102(b) must sufficiently describe the claimed invention to have placed the public in possession of it. Such possession is effected if one of ordinary skill in the art could have combined the

publication's description of the invention with his own knowledge to make the claimed invention. Accordingly, *even if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it is not enabling.*

*Id.* at 553, 226 U.S.P.Q. at 621, emphasis added, cited in *Elan Pharm., Inc. v. Mayo Found. for Med. Educ. & Research*, 346 F.3d 1051, 1054 (Fed. Cir. 2003).

Although Srinivasan et al. mentions a retro-inverso peptide analog of CD28, Srinivasan et al. does not disclose the sequence of such a peptide analog, or the size of such a peptide analog, or any other feature of the peptide analog that would place such peptide analog in the possession of those of ordinary skill in the art. Lacking such a disclosure, Srinivasan et al. does not enable a peptide mimetic that is 20-25 amino acids in length and that comprises the sequence set forth in SEQ. ID NO: 5 when the peptide mimetic comprises levorotary amino acids or the sequence set forth in SEQ ID NO: 6, when the peptide mimetic comprises dextrorotary amino acids, as recited in claim 1. Moreover, Srinivasan et al. does not indicate that the peptides recited in claims 1, 3-6, 10, and/or 13 of the present application were in public use or on sale more than one year prior to the filing date of the patent application. As a result, Srinivasan et al. does not anticipate the peptides recited in claims 1, 3-6, 10, and 13. Accordingly, Applicants submit that the rejection of claims 1, 3-6, 10, and 13 should be withdrawn.

The Office states that Applicants' arguments have been considered but are not deemed persuasive. The Office states that "Srinivasan et al. teach a CD28 retro-inverso peptide analog, while the instant specification evidences on page 14, lines 18-19, that the CD28 retro-inverso peptide analog has the sequence of SEQ ID NO:6." (Page 4, lines 5-7.) "Therefore, the sequence of the claimed peptide mimetic is the inherent property of the peptide mimetic taught

by Srinivasan et al.” (*Id.*, lines 7-9.) Applicants respectfully submit that the reference to the inherency doctrine does not save the rejection and only confuses the issue.

Applicants respectfully submit that if the Office’s position were correct, then the longstanding requirement for an enabling anticipation would be rendered meaningless. That is, faced with a document that generally discloses a claimed invention but fails to disclose the specifically claimed elements and how to make the invention, i.e., does not *enable* the later claimed invention, the Office could always argue that the missing teachings were inherent. Thus, the Office could defend its reliance on any non-enabling disclosure by arguing that the non-enabled disclosure was inherent, essentially eviscerating the enablement requirement.

Applicants respectfully submit that Srinivasan et al. does not constitute an enabling disclosure of the claimed invention, and therefore, that the rejection under 35 U.S.C. § 102(b) over Srinivasan et al. is untenable.

#### Conclusion

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1, 3-6, 10, 13, 17, 18, 20, 26, and 27 in condition for allowance. Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is not anticipated by the cited prior art reference. Applicants therefore request the entry of this Amendment, the Examiner’s reconsideration and reexamination of the application, and the timely allowance of the pending claims.

*Application No. 09/990,574*  
*Attorney Docket No. 18525/04028*  
*Response to Office Action*

If there is any fee due in connection with the filing of this Response, please charge the fee to our Deposit Account No. 03-0172.

Respectfully submitted,

Date: December 2, 2005

A handwritten signature in black ink, appearing to read "Sean Myers-Payne", written over a horizontal line.

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